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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/194,051 03/25/99 SUGIYAMA

A 051508/0103

EXAMINER

TM02/0727

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ART UNIT

PAPER NUMBER

2161

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07/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/194,051

Applicant(s)

SUGIYAMA, AKIRA

Examiner

Calvin L Hewitt II

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☒ Claim(s) 16-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Status of Claims

1. Claims 1-39 have been examined.

Response to Amendments/Arguments

2. In response to the Amendment, the Examiner maintains the objection to claims 16-22 because the word "mater" is misspelled. The Examiner also maintains the 112-second paragraph rejection to claim 4 for continuing to recite the term "peculiar". The term is vague and the Applicant does not provide sufficient information such that one of ordinary skill of the art would identify that is peculiar to a computer. Similarly, claims 10 and 16-19 are rejected because they recite the term "various".

Regarding the Official Notices, in Europe, smart cards are very popular within the banking industry. For example, French banks began issuing these cards around 1984. Attorneys use personal computer software applications to draft correspondence with the USPTO. Within a firm, an attorney has a word or data processing application running on his or her desktop. This was not possible before the shift away from mainframes where the application would instead be stored on a central computer.

Finally, the Examiner would like to address the Applicants' sentiment regarding the Examiner's appliance of the prior art, in particular, the Examiner's motivation statements. The Examiner would like to refer the Applicant to page 2100-101 of the MPEP, which clearly states,

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge, generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law.

Therefore, the Examiner maintains the rejection to claims 1-39.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 5,933,625 in view of Ishiguro et al., U.S. Patent No. 5,502,765 and Examiner's Official Notice.

As per claims 1-39, the Applicant in U.S. Patent No. 5,933,625 claims a unique time generating device that:

- sequentially outputs unit time values at predetermined intervals over a preset time measuring period with given start and end points (claim 1- column/line 23/45-24/11)
- accumulates time values over the time-measuring period (claim 1- column 24, lines 3-7)
- provides for the communication between a plurality of computers of data based on timer signals (claims 5 and 6- column 24, lines 23-39)
- provides a master and subordinate processing environment (claims 6 and 7, column 24, lines 36-45)

The Applicant in U.S. Patent No. 5,933,625 does not teach of "time" renewal in claims 1-7. But, the Applicant does teach of time data being accumulated over a "pre-set time measuring period" and a timer that generates "periodic timer signals". Hence, it would have been obvious to apply "time" renewal means to the system and store these renewals in the system in order to further the life of the system and facilitate transactions whose life cycle extends beyond the initial fixed time period.

However, the claims do not teach of registering means, appending new data to existing data, IC cards and IC card applications, card verification, data collation, data updates and storage of time data. Ishiguro et al. disclose an IC card settlement method with a system of management, terminal and dispenser computers that provide for:

- appending new data to existing data (column 13, lines 47-55; column 26, lines 11-24)
- registration means (column 13, lines 51-55; column 14, lines 3-5; column 15, lines 37-40; column 16, lines 7-10)
- IC cards and IC card applications (figure 1; column 1, lines 11-67; column/line 5-42-6/13; column 8, line 33-47; column 20, lines 10-29)
- IC card storage (column 9, lines 6-21; column/line 16/58-17/16)
- card verification, validation and invalidation (column/line 7/60-8/23; column 8, lines 48-51; column 9, lines 6-22; column 14, lines 3-25; column/line 17/60-18/2)

- time-data and data collation (column/line 7/60-8/23; column 8, lines 48-51; column 9, lines 6-22; column 16, lines 1-10; column 17, lines 5-16)
- (sequential) time data updates and storage (column 15, lines 37-63; column 16, 1-10)
- using time data to authorize cards (column/line 15/54-16/10; column/line 17/5-18/2; column 25, lines 50-53)
- input/output devices (column/line 5/65-6/6)
- data unique to a computer and card (column 15, lines 28-67; column 25, lines 45-54)

In addition, Ishiguro et al. apply their system to remote computers in a communication link with a management center (figure 1; column 5, lines 42-64; column 7, lines 51-59; column 11, lines 3-11; column 13, lines 48-54; column 14, lines 3-8; column 15, lines 54-60; column 20, lines 10-29; column 25, lines 28-63; column 26, lines 3-10). As well as local computers possessing the authorization functionality of a management computer (column 20, lines 10-29; column 24, lines 19-39; column 26, lines 10-24). Distributive business systems are well known and widely used. It is also well known that the reduction in computing costs and the increase in processing speed has lead to a paradigm shift away from mainframes. Hence, firms have increased the functionality of remote computers as well as the physical distance between these computers and the firms' central or main computer. In other words, the role played by

these remote or local computers in terms of executing a firm's objectives has become primarily a matter of design as the technology exists to support most enterprise models. Further, it would have been obvious to have the system's central, main, supervisor, managerial... etc. computer to take on the role of "official time-keeper". As the central computer serves as the controller and primary processing reference for a plurality of subordinate computers (figure 1), all other computers should be synchronized in accordance with the managerial computer (figure 1) in order to maintain system integrity.

However, neither the Applicant in claims 1-7 of U.S. Patent No. 5,933,625 nor Ishiguro et al. detail the system in terms of specific commerce applications of an IC or smart card. While Ishiguro et al. mention pre-paid cards (column 15, lines 9-11) and telephone controllers (column 15, lines 16-19) for example, absent are the business systems that support these and other IC card functions. Hence, the Examiner takes Official Notice that IC or smart cards that are used in electronic money applications or monetary transactions and that interact with gaming, banking or travel computers systems are well known in the art of online or offline electronic commerce. Therefore, it would have been obvious to combine the Applicant's teachings with those of Ishiguro et al.

In claims 5 and 6 of U.S. Patent No. 5,933,625, the Applicant details a system where computers communicate using unique time data. While Ishiguro et al. disclose an IC card verification system where computers exchange data via a communication network (column 5, lines 41-64). Ishiguro et al. also provide a system where card validation is conducted over said network using time stamp data (column/line 15/12-

18/26). Note Ishiguro et al. do not specify nor does they're verification approach rely upon any particular time keeping method. Therefore, their method for account settlement via IC cards is time keeping method independent and would work equally well whether using Greenwich time or the "unique" time approach put forth by the Applicant (U.S. Patent No. 5,933,625).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Brandt et al. teach a computer apparatus and method for communicating between software applications and computers via the world wide web
- Nakamura et al. disclose a system and method for revaluation of stored tokens in IC cards
- Ohashi et al. teach an authentication system

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 305-0625. The examiner can normally be reached on Monday-Friday from 8:30 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to"

Commissioner of Patents and Trademarks

C/o Technology Center 2700

Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

Art Unit: 2161

or:

(703) 308-5397 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should
be directed to the Group receptionist whose telephone number is (703) 305-3900.

Calvin Loyd Hewitt II

July 25, 2001



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100